

REMARKS

In accordance with the foregoing, claim 35 has been cancelled without prejudice or disclaimer and claims 1-3, 5, 12-17, 33 and 34 have been amended. No new matter is being presented. Therefore, claims 1-34 are pending and reconsideration is respectfully requested.

ENTRY OF AMENDMENT UNDER 37 C.F.R. §1.116:

Applicants request entry of this Rule 116 Response because the amendments of claims 1, 33 and 34 are meant to improve the form of the claims and do not substantially affect the scope of the claims, and because rejected claim 35 has been cancelled, thus, reducing the number of issues for appeal. Similarly, the amendments to claims 2, 3, 5 and 12-17 are being made to improve the form of the claims and do not substantially affect the scope of the claims.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

CLAIM OBJECTIONS:

Claims 2, 3, 5, 12-17 and 35 have been objected to. While it is believed that these claims were otherwise proper dependent claims, since claims 2, 3, 5 and 12-17 have been amended in accordance with the comments of the Office Action and since claim 35 has been cancelled, applicants respectfully request that the objections be withdrawn.

DOUBLE PATENTING:

Claims 1-35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 7,009,926. Claims 1, 2, 4-9, 12, and 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,934,236. However, since no indication

has been given that the claims in the present application are allowable, it would be premature to respond to the obviousness-type double patenting rejections at this time.

REJECTIONS UNDER 35 U.S.C. §102:

Claims 1 and 33 are rejected under 35 U.S.C. §102(e) as being anticipated by Ko (U.S. Patents 6,868,054, 7,046,605, or 7,142,493). These rejections are traversed.

Regarding the rejection of claim 1, it is noted that claim 1 recites detecting compatibility information from at least one of the lead-in and lead-out areas, the compatibility information allowing a drive following an older version of standards to record and reproduce data with respect to the information storage medium following a new version of standards. The claim further recites transferring data to and from the user data area in accordance with the compatibility information to make the drive of the older version of the standards compatible with the information storage medium of the new version of the standards via an application of the detected compatibility information.

On the other hand, none of the references to Ko disclose compatibility information that allows a drive following an older version of standards to record and reproduce data with respect to the information storage medium following a new version of standards. None of the references disclose transferring data to and from the user data area in accordance with the compatibility information to make the drive of the older version of the standards compatible with the information storage medium of the new version of the standards. Further, none of the references to Ko disclose lead-in or lead-out areas.

As to the first and second points, it is noted that the references to Ko disclose a disc 12 with an extended part version 2.3, a latest part version having reproducing compatibility 1.9, and a latest part version having recording compatibility 2.0 that is installed in a drive 14 with part version 1.9. Here, the references each disclose that while data can be reproduced from the disc 12, data cannot be recorded on the disc since, while identifying a standard of the disc, there is no information which allows such compatibility.

This is in contrast with the claimed invention in which the claimed compatibility information allows a drive following an older version of standards to record data to the information storage medium following a new version of standards.

Further, it is noted that, what appears to be extended compatibility data, where, as shown

in FIG. 2, the first and second decimal places can be used to identify base versions and a latest version which is still compatible with a prior version, the identification of version information in the Ko references does not provide information allowing for a use of the disc in non-compatible disc drives, but instead, merely distinguishes readable discs of one version from non-readable discs of another version.

As to the third point, that the references each fail to disclose these features have been acknowledged by the Examiner in the Office Action. As such, the Examiner is prevented from establishing a prima facie case for the 102(e) rejection of claim 1.

Thus, applicant respectfully asserts that claim 1 is patentably distinguished from the references to Ko and that, therefore, the rejection of claim 1 is believed to be overcome.

Regarding the rejection of claim 33, it is noted that claim 33 recites similar features as claim 1 and that, therefore, the rejection of claim 33 is believed to be overcome for similar reasons as set forth above.

To the extent that claims 1 and 33 were also rejected under 103(a), it is noted that 35 U.S.C. §103(c) bars any such rejection since the references to Ko and the present invention were subject to an assignment to the same assignee at the time of the filing of the present invention.

REJECTIONS UNDER 35 U.S.C. §103:

Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over the art as applied to claims 1 and 33 above and further in view of Tasaka et al (U.S. Patent 7,068,579), claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over the art as applied to claim 1 above and further in view of Sasa et al (U.S. Patent 6,628,595, Column 8, Line 39) with respect to the DVD Specification, July version 1.9, claims 4-8, 12, 13, 14, 15, and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over the art as applied to claim 1 above and further in view of Lim (U.S. Patent 6,330,215), claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over the art as applied to claim 12 above and further in view of Miyake et al (U.S. Patent 6,580,684), claims 18-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Ko references further considered with Miyake et al (U.S. Patent 6,580,684), claims 24-35 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Ko references further considered with Tasaka et al (U.S. Patent 7,068,579) and all further

considered with Miyake et al (U.S. Patent 6,580,684). However, as noted above, 35 U.S.C. §103(c) bars these rejections since the references to Ko and the present invention were subject to an assignment to the same assignee at the time of the filing of the present invention. Further, it is noted that none of the additional references cure the defects of the Ko references as noted above.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited. If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Finally, if there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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